

REMARKS

This paper is filed in response to the Notice of Panel Decision from Pre-Appeal Brief Review dated July 20, 2006. This paper is timely-filed as it is accompanied by a petition for an extension of time to file in the second month and a check covering the requisite small entity extension fee of \$225.

Claims 4-6, 8-11, and 15-20 are pending and at issue. By the foregoing amendments, claims 4-6, 8-10, and 15-17 have been amended. Support for the amendments may be found variously throughout the application and in the claims as originally filed. No new matter has been added.

As an initial matter, the Applicant wish to thank the examiner for conducting an interview with the undersigned attorney on August 18, 2006, and clarifying the Pre-Appeal Panel's decision to minimize the issues in the application by rejecting claims 4-6, 8-11, and 15-20 under 35 U.S.C. §103(a) as obvious over (only) the combination of U.S. Patent No. 3,825,253 to Speyer (hereafter, "Speyer") and U.S. Patent No. 4,971,305 to Rennex (hereafter, "Rennex"). *See* interview summary dated August 25, 2006 at page 3. Claims 5, 9, and 16 have also been rejected under 35 U.S.C. §112, second paragraph, as indefinite. *See* interview summary dated August 25, 2006, at page 3

The various bases for the claim rejections are addressed below. Reconsideration of the application, as amended and in view of the following remarks, is solicited.

CLAIM REJECTIONS – 35 U.S.C. §112

Claims 5, 9, and 16 have been rejected under 35 U.S.C. §112, second paragraph, as indefinite.

Claims 5, 9, and 16 have been amended to correct the asserted indefiniteness problems. It is respectfully submitted that the asserted indefiniteness problem did not render claims 4, 8, and 15 indefinite under §112, however, because a claim is considered definite as long as "the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent." *See* M.P.E.P. § 2173. Nevertheless, in view of the amendments to claims 5, 9, and 16 presented herein, the rejections of claims 5, 9, and 16 for indefiniteness should be withdrawn.

CLAIM REJECTIONS – 35 U.S.C. §103

The applicants respectfully traverse the rejections of claims 4-6, 8-11, and 15-20 as obvious over the combination of Speyer and Rennex.

A *prima facie* case of obviousness requires the satisfaction of three legal criteria. First, there must be some suggestion or motivation, either in the references themselves, or in knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success in doing so. Third, prior art references, when combined, must teach or suggest all of the claim limitations. See M.P.E.P. §2142. These criteria have not been satisfied with respect to all pending claims 4-6, 8-11, and 15-20, as explained in more detail below.

Speyer merely discloses a weight training apparatus comprising a barbell and a set of free weights including a centrally disposed bore and a slot. Speyer does not disclose or suggest combining such a weight training apparatus with at least one half-ounce incremental weight, at least one one-ounce incremental weight, and at least one two-ounce incremental weight, as recited by pending apparatus claims 4-6 and 8-11. Similarly, Speyer does not disclose or suggest “providing a group of incremental weights including at least one half-ounce incremental weight, at least one one-ounce incremental weight, and at least one two-ounce incremental weight,” as recited by method claims 15-20. In view of this deficiency, the examiner turned to Rennex.

Rennex discloses “a device which enables weight trainers to more conveniently select a particular weight and to make this weight selection with smaller weight increments than heretofore has been possible.” See Rennex abstract. Rennex discloses various increments with the smallest being 0.2 pounds (*i.e.*, 3.2 ounces). See Rennex at column 3, lines 10-12 and 40-43.

In contrast to Rennex, the present application specifically discloses that one-half ounce to one-ounce incremental gains should be made between workouts for “for smaller muscle groups, such as, for example, forearm, hand, and triceps.” Similarly, the present application discloses that children and persons affected by existing injuries should make relatively small gains between workouts. See application at page 9, line 36 – page 10, line 4. The *smallest* increment in Rennex is more than one and one-half times the *largest* increment

recited in independent claims 4, 8, and 15; accordingly, Rennex does not provide a system where such small incremental gains can be made.

When at least one half-ounce incremental weight, at least one one-ounce incremental weight, and at least one two-ounce incremental weight are provided, as recited by all pending claims, a weightlifter can incrementally increase a starting resistance by any of (i) one-half ounce (0.50 oz.), (ii) one ounce (1 oz.), (iii) one and one-half ounces (1.50 oz.), (iv) two ounces (2 oz.), (v) two and one-half ounces (2.50 oz.), (vi) three ounces (3 oz.), and (vii) three and one-half ounces (3.50 oz.) by using the appropriate combination of incremental weights. Such a wide variety of incremental weight increases permits a weight lifter to consistently increase exercise intensity safely, *i.e.*, without sacrificing good weight training form.

Further, notwithstanding its disclosure of increments as small as 0.2 pounds, *Rennex does not disclose any advantage* that is *specific* to such a small increment relative to a larger increment. Thus, Rennex does not disclose or suggest any motivation for using at least one half-ounce incremental weight, at least one one-ounce incremental weight, and at least one two-ounce incremental weight in combination with a weight training apparatus such as a standard barbell and set of free weights or a cable-type weight training apparatus, as claimed.

For a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. *See In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified is not sufficient to establish a *prima facie* case of obviousness. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

For the foregoing reasons, the applicants respectfully submit that a *prima facie* case of obviousness has not been established. Accordingly, the obviousness rejections of claims 4-6, 8-11, and 15-20 as obvious over the combination of Speyer and Rennex have been overcome and should be withdrawn.

CONCLUSION

It is respectfully submitted that the application is now in condition for allowance. Should the examiner wish to discuss the foregoing amendments and/or comments, or any matter of form or procedure in an effort to advance this application to allowance, he is respectfully invited to contact the undersigned attorney at the indicated telephone number.

Respectfully submitted,

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